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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,882	03/27/2001	Harry A. Reimer	S01.010	2429

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NEW CANAAN, CT 06840

EXAMINER

MARKS, CHRISTINA M

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 12/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/818,882

Applicant(s)

REIMER, HARRY A.

Examiner

C. Marks

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

The uses of the trademarks WEBTV (page 6, line 25), PLAYSTATION (page 7, line 6) and INTEL PENTIUM (page 10, line 21 and page 13, line 5) have been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

The disclosure is objected to because of the following informalities: On page 2, line 21 either the number 1,000 is misprinted as 1,00 or a comma has been inadvertently added to the number 100.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

Art Unit: 3713

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-23 and 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over SameGame (Amiga Freeware) in view of the collective teachings of Kilby et al. (*Casino Operation Management*), Robb (US Patent No. 6,488,580), and Brown (*Inside Pachinko: Skill or Pure Luck*) further in view of Oscar Sundbom (README for *Black-Hole v 1.0*).

It is known in the gaming environment that the goal of the casino industry is to maximize profit and always keep an acceptable margin of profit in all business decisions (Kilby et al, page 198). This concept axiomatically applies not only to such things as awarding a complimentary to a customer, but also to the decision of what games to purchase for the casino. A casino manager would not willingly purchase a gaming device that puts the casino at a disadvantage for profitability. Such a known example of this concept is in the adaptation of games of skill into games of chance.

Robb (US Patent No. 6,488,580) teaches that most gambling games are based heavily on chance and there are some that require some skill for success wherein the success must be measured against an inherent house advantage (Column 1, lines 5-10). Games of pure or primarily of skill have not previously been successfully used in casinos because the skill element can overwhelm the inherent house advantage, thus making such games unprofitable (Column 1, lines 11-14). However, these games of skill are highly attractive to players who enjoy the possibility of using their skills and wits to overcome the odds against them. Therefore a need exists that allows players to play a game of skill, which is highly attractive to them, in a manner

Art Unit: 3713

that maintains a predetermined house advantage. Robb discloses a means of setting levels and score thresholds to keep the advantage. However, another known means to keep an advantage exists in simple rule adaptation of the game.

An example of rule adaptation is shown in the adaptation of pinball for the gaming industry. A well-known game of skill is pinball. Pinball is a game in which the user controls one or more flippers in order to prevent a ball from falling out of play. There are many routes in which the user can direct the ball and based upon the users skill, a plurality of prize points may be accumulated as well as special features based upon where the ball is directed.

Pachinko is the adaptation of pinball into a gaming environment. This is accomplished by changing some of the fundamental rules in order to adapt the game of skill into a game of chance to ensure the profitability of the casino. By taking away the user controlled flippers and using a computer program (Brown, page 1) to determine the outcome of the game, the casino is able to maintain control of the profitability margin. By this simple rule adaptation to a well-known game of skill, it is possible to incorporate the fundamental basics into a game of chance wherein the customer still feels like they have control over the outcome based upon being allowed to input the start of the game. However, because of rule adaptation to use the computer program that is used to control the sequence in which the events will take place, the casino is able to maintain the game as a profitable one.

A game of skill is disclosed by SameGame (Amiga Freeware). SameGame is a game in which a game board with a plurality of game icons is displayed in order for the player to make a series of moves. The player chooses a block or set of blocks (of the same neighboring icon type) and at least one game icon from the board is removed based upon the player input from a player

device and the board is reconfigured by a reconfiguration rule specifying the direction the icons will move to make a new pattern. The greater the number of symbols the player removes, the greater the associated score will be (pages 1 and 5). The reconfiguration rule to be applied for a predetermined number of moves is indicated to the player through the documentation for the game. This reconfiguration rule states, "After a block is removed, the pieces above it drop down to fill the empty space. When a column is empty, all columns right of it are shifted to the left (page 5). The game result is determined based upon the series of game moves (page 5). The game can be played on a personal computer. Though Amiga Freeware allows the game to be downloaded from their site and played on a personal computer, it would have been obvious alternative to one skilled in the art at the time of the invention to host the game on the site instead of allowing player to download it. Therefore, the game could be accessed over the Internet from any location using a personal computer as a remote input device.

Based upon the collective teachings of Kilby et al., Robb, and Brown, it would have been obvious to one skilled in the art at the time of invention to adapt the SameGame to indicate to the player the reconfiguration rule to be applied only for the game play to which it is applicable and not indicate future reconfiguration rules. This concept of showing only the direction for the current piece and not that of futures pieces is also taught by Oscar Sundbom (README for Black-Hole v1.0). By doing this, the popular game of chance could then easily be incorporated into a gaming environment where players could make a wager to play (via means of any well-known payment method) and be rewarded a prize based upon the outcome of the game. Because SameGame is solely a game of skill, it would be absolutely necessary that a means of control be added to the game in order to incorporate it into the gaming environment.

This modification is what one of ordinary skill in the art would have to do to convert the game for gaming environment play for casino profit. It would be necessary because as taught by Kilby et al., an acceptable margin of profit is a requirement in casino management where a game has a payout based upon play and this acceptable margin would not be present in a solely skill based game. One would be motivated to adapt SameGame into a casino game based upon the teachings of Robb that state that games of skill are highly attractive to players who enjoy the possibility of using their skills and wits to overcome the odds against them. Further, one would be motivated to use a rule adaptation, as taught by Brown, to accomplish the requirements of Kilby et al. to obtain the attractiveness disclosed by Robb. Therefore, it would have been obvious to one skilled in the art at the time of invention to use a reconfiguration rule that is not immediately disclosed in order to exert control over the game and allow the game to be played in a gaming environment where a prize is awarded. Axiomatic to having a variety of reconfiguration rules to apply to the game in order to convert it closer to a game of chance, would be storing the available rules in a database form and determining which rule is to be applied, either by a random choice or a predetermined sequence.

Regarding claims 19 and 22, it is well known in the art that a method as disclosed is a series of step that can be programmed into machine instructions. It is also well known that these instructions can be stored on a machine-readable medium in order to allow a processing device, such as a game controller with a processor and memory, to perform the steps of the method. Furthermore, the storage device would axiomatically hold game information.

Claims 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brooks (US Patent No. 6,273,420) in view of Messina (US Patent No. 4,248,422).

Brooks discloses a method of facilitating game play in a game of skill wherein a player makes a series of game moves (Abstract, lines 10-11). The game board, in the form of the maze, is reconfigured as the player moves through the maze based upon a particular vision setting. The reconfiguration includes the direction and distance in which the player can see the actual maze. Brooks discloses that the player can choose which vision setting rule be applied during the game.

Messina teaches that once skill has been gained with a particular maze, the challenge is lost and interest wanes with continued use. A more difficult maze would make the game more interesting for an experienced player (Column 1, lines 17-21).

By these teachings, it would have been obvious to one skilled in the art at the time of invention that to accommodate experienced players, a more difficult maze would be required. By not allowing the player to choose their vision setting, and applying a vision setting during a game move that is not indicated to the player, a more challenging game would be created thus keeping the interest of the more experienced player. For these reasons, it would have been obvious to one skilled in the art to incorporate the maze teachings of Messina into the maze disclosed by Brooks.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent No. 6,352,475: Computer game for aligning icons in a field. When icons are matched up they disappear from the screen.

The New Tetris: Game where when a line of icons is formed it disappears and everything above it drops below. Feature is also available wherein you can send remaining bricks to other players wherein the reconfiguration of such an event is not disclosed to the player before it happens.

US Patent No. 5,423,556: Game where a plurality of icons are presented to the user and when a row or column with a predetermined pattern of features is formed, it is erased from the display and the remaining icons are shifted to the left.

US Patent No. 5,265,888: Game wherein a plurality of icons are presented to a player with different types and the player aligns up the icons based upon color and when two or more objects are detected as being continuously aligned in a vertical or lateral direction, they are erased and remaining portions previously supported by erased objects are displayed as falling.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Marks whose telephone number is (703)-305-7497. The examiner can normally be reached on Monday - Friday (7:30AM - 4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, V. Martin-Wallace can be reached on (703)-308-1148. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-872-9302 for regular communications and (703)-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-1148.

Cmm
cmm
December 4, 2002



**MICHAEL O'NEILL
PRIMARY EXAMINER**